

REMARKS

The Applicants have amended the claims to more clearly recite the invention. The Applicants have also provided remarks below, in response to the rejections in the Office Action. In light of the amendments above and the remarks that follow, the Applicants respectfully submit that all the claims of the application are patentable and in condition for allowance.

Claim Amendments

Claims 22-31 were filed by preliminary amendment in this continuation application, and amended in the paper filed October 17, 2003.

Claims 32-44 have been canceled without prejudice.

New claims 45-47 recite a mold shell holder assembly.

New claims 48-50 recite a mold shell assembly.

Priority Claim

The Examiner did not enter the claim of priority to a foreign application on the grounds that it was not timely. The Applicants filed a "Petition to Accept an Unintentionally Delayed Claim of Priority Under 35 U.S.C. § 119 to a Foreign Application." The Petition was granted in a decision mailed February 3, 2006.

Claim Rejections

The previously pending claims were not rejected based on prior art in the outstanding office action. The new claims filed herein contain the same or similar limitations and are also patentable over the cited art.

New independent claim 45 recites a mold shell holder assembly with a quick-fixing locking member. New independent claim 47 recites a mold shell holder assembly with at least two axial positioning assemblies.

New independent claim 48 recites a mold shell assembly with a pair of mold shells "defining one or more bearing surfaces defined to receive a quick-fixing locking member." New

independent claim 50 recites a mold shell assembly with a pair of mold shells “defining at least two axial positioning grooves.”

The Applicants therefore submit that all the pending claims are patentable over the cited prior art.

The Recapture Rejection

The Examiner rejected claims 22-44 under 35 U.S.C. § 251 as being an improper recapture of surrendered subject matter.

Claims 32-44 have been canceled.

The Related Appeal: The present application is a continuation of an application for reissue of U.S. Patent No. 5,968,560 (“the ‘560 patent”). The application for reissue remains pending, on remand after an appeal, and bears Application No. 09/553,413 (“the parent reissue application”). A recapture rejection was asserted in the parent reissue application. On appeal to the Board of Patent Appeals and Interferences, Appeal No. 2006-0123, the recapture rejection was reversed in a Decision on Appeal mailed February 24, 2006.

During prosecution of the original application, claim 1 was amended to recite mold carriers “which are made in the form of enveloping structures.” Claim 1 of the issued ‘560 patent includes that limitation. Claim 1 recites a device for manufacturing containers; more specifically, a combination of shells, shell holders, and mold carriers. The Board found no recapture in reissue Claim 15, for example, because the limitation on the shape of the mold carriers added to distinguish the prior art also implicitly limited the shape of the shell holders, and that limitation on the shape of the shell holders is retained in Claim 15 directed to the mold assembly subcombination. Applying the reasoning of the Board in its Decision on Appeal to the present recapture rejection, the Applicants respectfully submit that the recapture rejection should be withdrawn.

Claims 22-26 and 27-31 to a Mold Assembly and an Article

The pending reissue claims 22-26 and 27-31 include the same limitation on the shape of the shell holders. Independent claim 22 recites, “two mold shell holders . . . said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures . . .

.” Independent claim 27 recites, “a mold shell holder . . . said shell holder being shaped to be supported by one of a pair of mold carriers made in the form of enveloping structures”

The pending reissue claims 22-26 and 27-31 are directed toward subcombinations, as compared to the combination recited in claim 1 of the ‘560 patent. Independent claims 22 and 27 recite at least one shell holder as an element of the claim, and include the shape limitation, quoted above. Because the pending reissue claims 22-26 and 27-31 are subcombinations rather than the combination recited in original claim 1, the reissue claims do not include the mold carriers; however, each claim limits the shape of the shell holders to be supported by two mold carriers made in the form of enveloping structures.

The claim limitation added to facilitate issuance of the ‘560 patent limited the two mold carriers by adding the phrase “which are made in the form of enveloping structures,” but also implicitly limited the shape of the shell holders to shapes that can be supported by such enveloping mold carriers. This limitation on the shape of the shell holders continues to be a required characteristic in the pending reissue claims 22-26 and 27-31. Because the limitation on the shape of the shell holders continues to be a required characteristic in the pending reissue claims, the Applicants are not recapturing subject matter pertaining to the claimed mold assembly that was surrendered to facilitate issuance of the ‘560 patent – despite the mold carrier not being an element of these claims – and the recapture rejection should be withdrawn.

New Claims 45-47 to a Mold Shell Holder Assembly

The new claims 45-46 and 47 include the limitation on the shape of the shell holders: “said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures.” Like claims 22-31, the new claims 45-47 are directed toward subcombinations that do not include the mold carriers; however, each claim limits the shape of the shell holders to be supported by two mold carriers made in the form of enveloping structures. Because this limitation on the shape of the shell holders continues to be a required characteristic in new claims 45-47, the Applicants are not recapturing subject matter pertaining to the claimed mold assembly that was surrendered to facilitate issuance of the ‘560 patent, despite the mold carrier not being an element of these claims.

New Claims 48-50 to a Mold Shell Assembly

Like claims 22-31 and 45-47, the new claims 48-49 and 50 are directed toward subcombinations, but in these claims the subcombination is the mold shell assembly. As such, the new claims 48-50 do not include the mold carriers or the mold shell holders as claim elements; however, each claim limits the shape of the mold shells to be “configured to be supported by mold carriers made in the form of enveloping structures via interposed mold shell holders, said mold shell holders being shaped to be supported by said mold carriers made in the form of enveloping structures.”

The claim limitation added to facilitate issuance of the ‘560 patent limited the two mold carriers by adding the phrase “which are made in the form of enveloping structures,” but also implicitly limited (1) the shape of the shell holders, and (2) the shape of the mold shells – to shapes that can be supported by such enveloping mold carriers. That implicit claim limitation of the mold shells continues to be a required characteristic in new claims 48-50. Because the shape limitation continues to be a required characteristic in the claims 48-50, the Applicants are not recapturing subject matter pertaining to the claimed mold assembly that was surrendered to facilitate issuance of the ‘560 patent – despite neither the mold carrier nor the mold shell holders being an element of these claims.

In conclusion, all the pending reissue claims, 22-31 and 45-50, include a limitation on one or more claim elements to be configured or shaped to be supported by mold carriers made in the form of enveloping structures. Applying the reasoning of the Board in its Decision on Appeal, the Applicants respectfully submit that the present recapture rejection should be withdrawn and the new claims should not provoke a new recapture rejection.

CONCLUSION

After entry of the requested amendment, claims 22-31 and 45-50 are pending in the application. In light of the amendments and the remarks presented, the Applicants respectfully submit that all the claims of the application are patentable and the application is now in condition for allowance.

The Applicants also submit herewith a Petition and Fee for Extension of Time, along with the required fee, and payment of the filing fee for one additional independent claim. The Applicants do not believe any fees for extensions of time or net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. In the event additional extensions of time are necessary to allow the consideration of this paper, such extensions are hereby petitioned-for under 37 CFR § 1.136(a) and any required fees (including fees for net addition of claims) are hereby authorized to be charged to Deposit Account Number 16-0605.

Respectfully submitted,

/Jeffrey E. Young/
Jeffrey E. Young
Registration No. 28,490

and

/J. Scott Anderson/
J. Scott Anderson
Registration No. 48,563

May 2, 2006
Electronically Filed

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Atlanta (404) 881-7000
Fax (404) 881-7777